

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM S. MEEKS and JEFFREY L. SOKOLOV

Appeal No. 2006-2790
Application No. 09/362,014
Technology Center 2100

Decided: February 23, 2007

Before LANCE LEONARD BARRY, MAHSHID D. SAADAT,
and JEAN R. HOMERE, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

I. STATEMENT OF THE CASE

An Examiner rejected claims 1-17, 26, 28, 30, and 36-43.

The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal concerns application sharing. Some application programs allow a user of a computer to share contemporaneously electronic media with users of other computers under the rubric "what you

see is what I see" or "WYSIWIS". Such programs feature some level of conferencing capability. (Specification 1.) Unfortunately, assert the Appellants, these programs require knowledge on how to use them for conferencing and require knowledge on how to configure them for application sharing. (*Id.* 2.)

In contrast, the Appellants' interface program reduces application sharing to a two-step process that hides underlying details from a user. In cooperation with a conferencing program, the interface program enables a user to select at least one file to be share and at least one participant with whom to share the file. Following the selections, the interface program automatically establishes application sharing. (*Id.* 40.)

A further understanding of the invention can be had by reading the following claims.

26. A method for storing an application-sharing meeting configuration, comprising:

providing a programmed computer system;

selecting a name to save state of the application-sharing meeting configuration;

saving an address for each participant;

saving descriptors for each shared application; and

adding the name to the application-sharing meeting configuration.

42. A computer system for application sharing, comprising:

a central processing unit;

memory operatively coupled to the central processing unit, the memory comprising:

an operating system for operation of the computer system;

a conferencing program;

an application program;

an interface program, the interface program comprising:

a graphic user interface, the graphic user interface in cooperation with the operating system configured for user selection of at least one window and at least one recipient;

the interface program in cooperation with the conferencing program configured to establish application shared viewing in response to selection of the at least one window and the at least one recipient;

a display device having a screen display;

at least one input device for manipulating image objects
on the screen display; and

at least one input/output device for operatively coupling
the computer system with at least one other computer system.

B. REJECTIONS

Claims 1-8, 10, 12-17, 42 and 43 stand rejected under 35 U.S.C.
§ 103(a) as obvious over U.S. Patent No. 6,308,199 ("Katsurabayashi") and
U.S. Patent No. 5,758,110 ("Boss"). Claims 9 and 11 stand rejected under
§ 103(a) as obvious over Katsurabayashi; Boss; and U.S. Patent No.
5,790,127 ("Anderson"). Claims 26 and 28 stand rejected under § 103(a) as
obvious over Katsurabayashi and U.S. Patent No. 5,907,324 ("Larson").
Claims 30 and 36-41 stand rejected under § 103(a) as obvious over
Katsurabayashi and Anderson.

Our opinion addresses the claims in the following order:

- claims 1-13, 42, and 43
- claims 14-17
- claims 26 and 28
- claim 30
- claims 36-41.

II. CLAIMS 1-13, 42, AND 43

Rather than reiterate the positions of the Examiner or the Appellants *in toto*, we focus on the point of contention therebetween. The Examiner asserts, "Katsurabayashi selects the visibility of **windows** . . . for given users, and in referring to individual windows, the windows have every capability and expectation of being opened upon particular document instances." (Answer 10.) The Appellants argue, "Katsurabayashi is directed, at most, to allowing users to share an *application*, not to allowing users to share selected files and/or documents *within an application*." (Br.¹ 5.) Therefore, the issue is whether Katsurabayashi would have suggested selecting and sharing documents, files, windows, or objects.

"In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the independent claims at issue to determine their scope. Second, we determine whether the construed claims would have been obvious." *Ex Parte Cuomo*, No. 2003-0509, 2004 WL 4978831, at *2 (B.P.A.I. 2004).

¹ We rely on and refer to the Second Revised Appeal Brief, in lieu of the Appeal Brief and the Revised Appeal Brief, because the latter were defective. The Appeal Brief and the Revised Appeal Brief were not considered in

A. CLAIM CONSTRUCTION

"Analysis begins with a key legal question — what is the invention claimed?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, claim 1 recites in pertinent part the following limitations:
"selecting at least one document to be shared by the host . . . and automatically establishing a substantially real-time shared viewing of the at least one document." Claims 2, 7, and 8 recite similar limitations. Giving claims 1, 2, 7, and 8 the broadest, reasonable construction, the limitations require selecting and sharing at least one document.

In contrast, claim 42 recites in pertinent part the following limitations:
"operating system configured for user selection of at least one window and at

deciding this appeal.

least one recipient; the interface program in cooperation with the conferencing program configured to establish application shared viewing in response to selection of the at least one window and the at least one recipient. . . ." Similar to claim 42, claim 43 recites in pertinent part the following limitations: "operating system configured for user selection of at least one object and at least one recipient; the interface program in cooperation with the conferencing program configured to establish application shared viewing in response to selection of the at least one object and the at least one recipient. . . ." The "object" of claim 43 is broad enough to read on a window. Giving claims 42 and 43 the broadest, reasonable construction, the limitations require selecting and sharing at least one window.

B. OBVIOUSNESS DETERMINATION

"Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious." *Ex Parte Massingill*, No. 2003-0506, 2004 WL 1646421, at *3 (B.P.A.I 2004).

The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . ." *In re Zurko*, 258 F.3d 1379, 1383, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir.

1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, we find that Katsurabayashi "relates to a cooperative work support system which displays a common screen on computer screens of a plurality of users to support cooperative work among the users through the screen display." (Col. 1, ll. 7-10.) More specifically, the system "provide[s] the ability to select windows to be displayed and those to be hidden in an application sharing system which allows a plurality of users to make discussions using a relationship among information items extending onto a plurality of application windows." (Col. 3, ll. 25-30.) "In this way, [a] plurality of personal computers 2A, 2B, 2C, and 2D exchange data through the network 1 and a screen shared by the participants A to D is displayed in a so-called multi-window display form in a controlled manner that displays or hides windows for each participant. . . ." (Col. 5, l. 66 - col. 6, l. 3.) "FIG. 2 [of the reference] shows the situation in which," (col. 6, ll. 6-9), "personal

computer 2A performs control so that all the windows are displayed to the participant B and one window W_i is not displayed to other participants C and D." (*Id.* ll. 9-12.)

We are unpersuaded that selecting and sharing windows would appear to have suggested selecting and sharing at least one document. The Examiner does not allege, let alone show, that the addition of Boss or Anderson cures the aforementioned deficiency of Katsurabayashi. Absent a teaching or suggestion of selecting and sharing at least one document, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the rejections of claims 1, 2, 7, and 8 and of claims 3-6 and 9-13, which depend therefrom.

Because Katsurabayashi provides the ability to select windows to be displayed and shared by a plurality of users, however, we agree with the examiner's finding that teachings from the prior art itself would appear to have suggested the selecting and sharing at least one window as in claims 42 and 43.

The Appellants also argue that "even if Katsurabayashi did teach sharing selected windows or objects, it is clear that any such selection would occur *after* a connection between the host and a client or clients had been

established" (Br. 9) We agree with the examiner, however, that "Katsurabayashi and Boss suggest the user's 'selecting', as is used to drive a 'real-time shared viewing' . . . , whether there had been connections of a more general nature made or not" (Answer 10). Therefore, we affirm the rejections of claims 42 and 43.

III. CLAIMS 14-17

The Examiner admits, "Katsurabayashi does not **explicitly** disclose that the contents of [its] management table are presented as a 'window list in a user interface'. . . ." (Answer 4.) Finding that "the emphasis in Boss is upon the control that the host user has over the sharing of the application" (*id.* 11), however, he asserts, "This suggests that a form of list become available to that host user. When extended to the multiple user environment of Katsurabayashi, such a user will have a 'window list' as per the claim, and one that must be managed according to 'at least one heuristic'" (*Id.*). The "Appellants respectfully submit that, even if the Examiner is correct that Boss emphasizes 'the control that the host has over the sharing of the application' . . . such a general teaching would not, contrary to the Examiner's unsupported assertion, have suggested that 'a form of list become[s] available to that host user.'" (Reply Br. 5.) Therefore, the issue is whether Boss would have suggested using a graphical ser interface ("GUI") to display a list of windows.

A. CLAIM CONSTRUCTION

Claim 14 recites in pertinent part the following limitations: "displaying the window list in a user interface. . . ." Claim 17 recites similar limitations. Giving claims 14 and 17 the broadest, reasonable construction, the limitations require using a GUI to display a list of windows.

B. OBVIOUSNESS DETERMINATION

"A rejection based on section 103 clearly must rest on a factual basis. . . ." *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). "The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." *Id.*

Here, Boss "relates to computer systems implementing a graphic user interface (GUI). More particularly, the [reference] relates to task-based application sharing in a graphic user interface such as Windows®." (Col. 1, ll. 12-15.) Furthermore, Boss discloses that "[a]ny window which belongs to the shared application is added to a shared windows list which is a list of all the shared windows belonging to the shared tasks." (Col. 6, ll. 19-22.) We find no teaching, however, that the reference displays the shared windows list via its GUI.

Absent a teaching or suggestion of using a GUI to display a list of windows, we are unpersuaded of a prima facie case of obviousness. Therefore, we reverse the rejection of claims 14 and 17 and of claims 15 and 16, which depend from the former.

IV. CLAIMS 26 AND 28

The Examiner finds that it would have been obvious "to use a coordinated saved representation of a 'meeting' with the conference object of Larson, in conjunction with the management table of Katsurabayashi . . . because this better preserves the structure of a collaborative work established by Katsurabayashi for later use." (Answer 8.) The Appellants allege, "In sum, the Office Action does not appear to suggest that motivation to combine Katsurabayashi and Larson is found in the prior art of record, and Appellants do not in fact believe that such motivation is found in the prior art of record." (Br. 10.) Therefore, the issue is whether a motivation to combine Katsurabayashi and Larson exists.

"The presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact." *In re Gartside*, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). A suggestion to combine teachings from the prior art "may be found in

explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999) (citing *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998)).

Here, Larson "discloses a method for storing, retrieving and dynamically establishing conference parameters in an electronic conferencing system." (Col. 4, ll. 43-45.) In particular, the method "allows a user to selectively store conference parameters into a persistent conference file/object and to dynamically establish a conference environment having the stored values by recalling a persistent conference object having the desired conference parameters/traits." (*Id.*, ll. 46-51.)

We find that the secondary reference offers several advantages. For example, "a participant can record many more characteristics of a conference (i.e., application and document use) than the prior art allowed." (Col. 2, ll. 60-62.) "Furthermore, a participant can now store characteristics and parameters of a conference session and automatically resume the conference at a later time without having to manually establish and input for the second time the various characteristics of the conference." (*Id.* ll. 63-67.) Larson "also provides not only for the storage of these conference characteristics, but

also for the automatic implementation of all the conference characteristics by one user-initiated command." (Col. 3, ll. 1-4.) In addition, the secondary reference "saves the participants tremendous amounts of time. . . ." (*Id.*, ll. 5-6.) We further find that these advantages would have provided a motivation to combine Katsurabayashi and Larson.

The Appellants also allege, "Larson teaches a system for storing parameters relating to a video conference. (Abstract; col. 5, line 57 - col. 6, line 35.) Accordingly, the conference object disclosed by Larson (Fig. 4) simply would not have been functional in the context of Katsurabayashi's application sharing system." (Br. 10-11.)

In Larson's electronic conferencing system, however, "the output from software applications running on, for example, Computer 10, may be simultaneously viewed on [its] Display 24, as well as Display Device 68 coupled to Computer 65." (Col. 6, ll. 15-19.)² Because both Katsurabayashi and Larson address sharing displays, we are unpersuaded by the Appellants' allegation. Therefore, we affirm the rejections of claims 26 and 28.

² In Larson, "Computer 10 is electronically coupled for communication with," (col. 5, ll. 63-64), "a Computer 65 which is coupled to a Display Device 68. . . ." (*Id.*, ll. 66-67.)

V. CLAIM 30

The Examiner makes the following assertions.

Anderson remains valid, for teaching that the various components of a collaborative work should be managed as to their availability. This necessarily involves the "determining" and "setting" steps of claim 30, in which querying merely takes place as to the state of a particular connection (the "use item"), with it becoming established at "an address of the use item" if it "is not in use".

(Answer 13.) The Appellants make the following argument.

[T]he Examiner points to no portion of Anderson that teaches or suggests the limitations of claim 30 of "determining if the use item is currently in use" and "if the use item is not in use, setting a label of the use item, to the target name; setting an address of the use item to the associated network address; and enabling use of the use item."

(Reply Br. 8.) Therefore, the issue is whether the examiner has met his initial burden of presenting a prima facie case of obviousness

A. CLAIM CONSTRUCTION

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir.

1983)). Here, claim 30 recites in pertinent part the following limitations:
"setting a use item equal to a menu item; determining if the use item is currently in use. . . ." Considering all these limitations, the claim requires *inter alia* setting a use item equal to a menu item and determining if the use item is currently in use.

B. OBVIOUSNESS DETERMINATION

"In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). Here, the examiner has not shown or attempted to show how the combined teachings of Katsurabayashi and Larson would have suggested the aforementioned limitations in combination with the other limitations of claim 30.

Absent a teaching or suggestion of setting a use item equal to a menu item and determining if the use item is currently in use, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the rejection of claim 30.

VI. CLAIMS 36-41

The Examiner alleges "that the management in Anderson is of connection status, and thus, 'the status information including the current number of participants' must be maintained." (Answer 14.) The Appellants argue, "At a minimum Anderson does not teach 'the status information including the current number of participants' as recited in claims 36 and 39." (Br. 14.) Therefore, the issue is whether Anderson inherently maintains the number of active participants in a call.

A. CLAIM CONSTRUCTION

Claims 36 and 39 recite in pertinent part the following limitations: "the interface program in cooperation with the call manager configured to maintain status information regarding the connectivity, the status information including current number of active participants." Considering all these limitations, the claims require maintaining the number of active participants in a call.

B. OBVIOUSNESS DETERMINATION

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed.

Cir. 1999) (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)). "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (citing *Hansgirg v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (1939)).

Here, assuming *arguendo* "that the management in Anderson is of connection status," (Answer 14), we cannot find that the reference necessarily maintains the number of active participants in a call. No evidence of record makes clear that such maintenance is necessarily present in Anderson, or that it would be so recognized by persons of ordinary skill. The Examiner does not allege, let alone show, that the addition of Katsurabayashi cures the aforementioned deficiency of Anderson.

Absent a teaching or suggestion of maintaining the number of active participants in a call, we are unpersuaded of a prima facie case of obviousness. Therefore, we reverse the obviousness rejection of claims 36 and 39 and of claims 37, 38, 40, and 41, which depend therefrom.

VII. CONCLUSION

In conclusion, the rejections of claims 1-17, 30, and 36-41 are reversed. The rejections of claims 26, 28, 42, and 43, however, are affirmed. Therefore, we affirm-in-part.

"Any arguments or authorities not included in the brief or a reply brief filed pursuant to [37 C.F.R.] § 41.41 will be refused consideration by the Board, unless good cause is shown." 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, our affirmance is based only on the arguments made in the briefs. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.") No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2006-2790
Application 09/362,014

AFFIRMED-IN-PART

LANCE LEONARD BARRY
Administrative Patent Judge

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